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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/147,237 04/20/99 YAGI

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HM12/0826

EXAMINER

PRATS, F

ART UNIT

PAPER NUMBER

1651

DATE MAILED:

08/26/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/147,237

Applicant(s)  
Eiichiro Yagi et al

Examiner  
Francisco C. Prats

Group Art Unit  
1651



☒ Responsive to communication(s) filed on Jun 25, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-14 is/are pending in the application.

Of the above, claim(s) 5-14 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-4 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**DETAILED ACTION**

1. Claims 1-14 are presented for examination.

***Election/Restriction***

2. Applicant's election of the group I invention, claims 1-4, in Paper No. 6, filed June 25, 1999 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

3. Claims 5-14 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. As discussed immediately above, election was made **without** traverse in Paper No. 6, filed June 25, 1999.

4. Claims 1-4 are examined on the merits.

***Information Disclosure Statement***

5. It is noted that the International Search Report and references cited therein are present in the file. Pursuant to the requirements of MPEP § 1983.03(g), note specifically that the references have been considered.

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***Claim Rejections - 35 USC § 112***

6. Claims 1-4 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation "characteristically contains" is indefinite because it is not clear what is meant by the recitation. First, it is not clear how the term "characteristically" qualifies the presence of the active ingredient. Also, the use of the term "containing" is indefinite because it is not clear whether the term is intended to encompass the presence of other ingredients in the claimed composition.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Hersh et al (U.S. Pat. 5,667,791).

9. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsuura et al (U.S. Pat. 5,407,667) or Hara et al (U.S. Pat. 5,316,767) or Demopolous et al (U.S. Pat. 5,204,114) or Oyama et al (U.S. Pat. 4,990,330).

10. Each of the cited references discloses glutathione-containing drugs which can be topically applied. A holding of anticipation is therefore clearly proper.

11. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F.C. Prats whose telephone number is (703) 308-3665.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael G. Wityshyn, can be reached on (703) 308-4743.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

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Communications applicant wishes to submit by FAX should be submitted to FAX # (703) 305-4242 or (703) 305-3014.



FRANCISCO C. PRATS  
PRIMARY EXAMINER  
ART UNIT 1651

F.C. Prats  
August 25, 1999